

AMENDMENT UNDER 37 C.F.R. 1.111

U.S. SERIAL NO.: 09/774,885

ATTORNEY DOCKET NO.: Q62892

### **REMARKS**

With this amendment, Applicant adds claims 29-32. Claims 1 and 3-32 are all the claims pending in the application.

#### **1. Claim Rejections Under 35 U.S.C. § 103**

The Examiner has rejected claims 1, 3, 4, 6, 7, 11, 14-18, 24, 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,361,203 to Hiyama *et al.* (“Hiyama”) in view of U.S. Patent No. 6,690,417 to Yoshida *et al.* (“Yoshida”). For at least the following reasons, Applicants traverse the rejection.

Claim 1 recites an image storage and display system that comprises a “storage control means [that] is capable of changing a compression ratio of said irreversible compressed image data.” The Examiner concedes that Hiyama does not disclose this feature but applies Yoshida to allegedly cure the deficiency.

In response to the arguments in the filing of December 21, 2005, that there is no disclosure or suggestion in Hiyama that the compression ratio needs to be varied, the Examiner contends that “the system of Hiyama does need to control the compressed data amount. In other words, the compression ratio needs to be controlled.” To allegedly support this contention, the Examiner cites a section of Hiyama that discloses that an alarm is issued to the endoscope devices when the available storage space in storage medium 77 is below a predetermined amount.

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Applicants submit that Hiyama does not disclose or suggest that, in compressing data, the compression ratio needs to be controlled. The system in Hiyama would work with a fixed compression ratio, e.g., 1/2. Since there is no disclosure or suggestion of changing the compression ratio in Hiyama, one skilled in the art can only presume that the data compression taught by Hiyama is at a fixed ratio.

The Examiner's contention that, because an alarm is used to control the amount of data storage in a storage medium, the compression ratio needs to be controlled is logically flawed. Hiyama discloses that, in the case of an alarm, "the large capacity storage medium 77 can be exchanged with a new one" by pressing a key on the control device 78. (Col. 6, lines 25-28.) Therefore, the "controlling" of the amount of data in a storage medium is accomplished by replacing the storage medium when it is full, not by changing the compression ratio. Varying the compression ratio is not even suggested by the Examiner's cited passage and is clearly not needed since a new storage device will store subsequent images.

Accordingly, because the Examiner's contention that there is a need to vary the compression ratio in the system of Hiyama is not supported, the Examiner's proffered reason for combining the teachings of Hiyama and Yoshida is also not supported by the prior art. Therefore, Applicants submit that the Examiner has failed to make a *prima facie* case of obviousness.

In addition, the system in Yoshida primarily looks at available space when varying the compression ratio (Abstract). There is no disclosure or suggestion that other factors (e.g., the subject matter of the image) are considered when varying the compression ratio. Without such

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teachings, Applicants submit that the data loss associated with the variable compression as taught by Yoshida may be detrimental in a system that requires high-quality images since it could create an image with too much data loss.

Although such a loss may not be critical for the digital camera/telephone disclosed in Yoshida, the loss of image data would be very critical for the medical endoscope images of Hiyama. Accordingly, one skilled in the art would not have combined the teachings as suggested by the Examiner, and the Examiner has failed to make a *prima facie* case of obviousness for this additional reason.

Because claim 14 recites features similar to that of claim 1 and the Examiner's rejection of claim 14 is similar to that given in claim 1, Applicants submit that the Examiner has failed to make a *prima facie* case of obviousness for at least reasons similar to those given above with respect to claim 1.

Applicants submit that claims 3, 4, 6, 7, 11, 15-17, 24, 27 and 28 are patentable at least by virtue of their respective dependencies.

In addition, with respect to claim 24, Hiyama does not disclose or suggest that two irreversible compressed images are created from the original image data. The Examiner's cited example (Office Action at page 8) would require two original images, not one as set forth in claim 24.

## **2. Allowable Subject Matter**

Applicants thank the Examiner for indicating that claims 5, 8-10, 12, 13 and 18-23 are allowable.

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Applicants also thank the Examiner for indicating that claims 25 and 26 would be allowable if rewritten in independent form. Applicants hold rewriting these claims in abeyance until the subject matter regarding claim 1 is resolved.

In the reasons for allowance, the Examiner partially quotes the features of claim 5 and does not accurately quote the language in claims 8 and 9. Applicants submit that each claim is patentable based on its own language and not based on any paraphrasing or addition of language that may have been made by the Examiner.

### **3. New Claims**

With this amendment, Applicants add claims 29-32. Applicants submit that these claims are patentable at least by virtue of their respective dependencies.

### **4. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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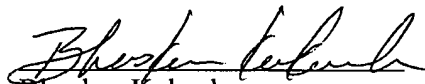
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